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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,250	01/21/2004	Kia Silverbrook	WAL06US	3253

24011 7590 12/07/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,250	Applicant(s) SILVERBROOK ET AL.	
	Examiner Stephen Gravini	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20041012</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Specifically, the incorporation of PCT/AU98/00550 appears improper because that reference is not included with the application.

Information Disclosure Statement

The information disclosure statement filed October 12, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Specifically the French reference information disclosure submission does not include a translation or explanation of relevance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation a printer, and the claim also recites such as a wallpaper printer which is the narrower statement of the range/limitation.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 1-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claim 1 is considered indefinite because of the broad recitation followed by a narrower recitation. Since claims 2-40 and 43-49 are dependent, either directly or indirectly, upon an indefinite claim, those claims are also considered indefinite because of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7, 9-17, 30-34, 36-38, and 42-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Stoffel et al. (US 6,412,990). Stoffel is considered to disclose the claimed invention comprising:

a compartment **10** with a top opening for receiving a media web **24** fed from the printer;

a source of heated air **418 & 420** located above the top opening for blowing heated air into the opening to dry printing on the media web. Stoffel is also considered to disclose the claimed closed door cover support **77**, transverse axis door opening (column 13 lines 1-3), motor operated door spool **18**, heating element blower heated air source **416**, partial loop web suspension with recirculating duct air from the compartment to an intake with a second blower and plural vents located above the plenum (column 14 lines 28-31 wherein the disclosed reservoir is considered to anticipate the claimed vents because both act as a conduit of fluid), a media supply slot

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with rollers with a consumer tote (column 11 lines 1-64), a cutting blade with one or more slitters (column 13 lines 35-38), the steps of utilizing an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a winding area, there being a print head located in the media path, a processor which accepts operator inputs from one or more input devices, using one or more input devices which communicate with the processor to capture data from an operator regarding a specification for an operator's requirements, using the processor to operatively control the printer according to the data, and printing a single roll of wallpaper, on demand, according to a selected pattern, which further utilizes an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a print head and from the print head to a dispensing slot, using one or more printer input devices which communicate with a processor to capture data regarding one or more customer's requirements, the data comprising at least a customer selected pattern, printing a roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern, and charging a customer for the roll, along with the steps of providing to franchisees, an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a print head and from the print head to a dispensing slot, the printer having one or more printer input devices which communicate with a processor to capture data regarding one or more customer requirements, the data comprising at least a customer selected pattern, providing the franchisee with a collection of patterns in a digital storage medium that can be read by the printer, enabling the franchisee to print a roll of wallpaper, onto a

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web of blank media, on demand, according to the selected pattern, and enabling or attempting to obtain a fee from the franchisee and a frame in which is located a media path which extends from a media loading area to a winding area, a print head located across the media path, one or more input devices for capturing operator instructions, a processor which accepts operator inputs which are used to configure the printer for producing a particular roll, and the winding area adapted to removably retain a core and wind onto it, wallpaper produced by the printer (column 11 line 43 through column 12 line 53 wherein the disclosed consumer transactions is considered to implicitly anticipate the claimed franchisee fee because both exchanger a product or service for a fee).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffel in view of Griffith (US 4,871,406). Stoffel is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed preheater. Griffith, another method of drying a moving web, is considered to disclose a preheater at column 2 lines 56-62. It would have been obvious to one skilled in the art to combine the teachings of Stoffel with the preheater, considered disclosed in Griffith, for the purpose of incrementally increasing the drying of a web such that overheating is prevented and gradually drying is achieved.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffel in view of Chaudhuri (US 4,202,723). Stoffel is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed temperature sensor. Chaudhuri, another method of drying a moving web, is considered to disclose a temperature sensor at column 2 lines 56-62. It would have been obvious to one skilled in the art to combine the teachings of Stoffel with the temperature sensor, considered disclosed in Chaudhuri, for the purpose of precisely controlling the drying of a web such that gradually drying is achieved and overheating is prevented.

Claims 18, 29, 35, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffel in view of Silverbook (US 6,180,427). Stoffel is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed processor controlled printer. Silverbook, another method of processing a moving web, is considered to disclose processor controlled printer at column 4 lines 12-34. It would have been obvious to one skilled in the art to combine

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the teachings of Stoffel with the processor controlled printer, considered disclosed in Silverbook, for the purpose of precisely control of the processing of a web such that gradually finishing is achieved and damage is prevented.

Claims 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffel. Stoffel is considered to disclose the claimed invention, as discussed above under the anticipatory rejection, except for the claimed print head rate and nozzles with ink drop volumes. It would have been an obvious matter of design choice to provide a specific quantity print head rate and nozzles with ink drop volumes, since the prior art cited in this application appears to achieve the same claimed invention result regardless of the print head rate and nozzles with ink drop volumes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference E, cited with this action, is considered to disclose one or more elements of the claimed web drying method.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira S. Lazarus can be reached on 571 272 4877. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG
November 30, 2004

A handwritten signature in cursive script, appearing to read "Stephen M. Shaw".